

In the United States
COURT OF APPEALS
for the Ninth Circuit

R. W. POINTER, doing business under the fictitious
name and style of Pointer-Willamette Co.,

Appellant,

vs.

SIX WHEEL CORPORATION, a corporation,

Appellee.

APPELLANT'S BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

HAROLD L. COOK,
LEE R. SCHERMERHORN,
Cook and Schermerhorn,
717 Corbett Building,
Portland 4, Oregon,
Attorneys for Appellant.

LYON & LYON,
LEWIS E. LYON,
811 West Seventh St.,
Los Angeles 14, Calif.;
GEISLER & GEISLER,
L. R. GEISLER,
Platt Building,
Portland, Oregon,
Attorneys for Appellee.

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vs.

SIX WHEEL CORPORATION, a corporation,

Appellee.

APPELLANT'S BRIEF

Upon Appeal from the District Court of the United
States for the District of Oregon.

STATEMENT OF JURISDICTION

Jurisdiction of the District Court.

This is a suit brought by Six Wheel Corporation, a corporation, upon a complaint filed May 11, 1946, in the District Court of the United States for the District of Oregon, against R. W. Pointer, residing at Portland, Oregon, and doing business under the fictitious name and style of Pointer-Willamette Co., for infringement of plaintiff's patent No. 1,926,727, issued September 12,

1933, on an application filed January 3, 1927, by one Garner L. Knox and assigned to the said Six Wheel Corporation. Jurisdiction was based upon section 41, paragraph (7), Title 28, U.S.C. (now sections 1338 and 1400 of Title 28). Plaintiff alleges that on September 12, 1933, Letters Patent No. 1,926,727 were duly and legally issued to plaintiff for an invention in Six-Wheel Attachment for Motor Vehicles, and since that date plaintiff has been, and still is, the owner of said Letters Patent; that defendant has been, and still is, infringing said Letters Patent by making, selling and using six-wheel running gears embodying the patented invention and will continue to do so unless enjoined; that plaintiff placed the required statutory notice on all running gears manufactured and sold by it under said Letters Patent, and gave notice in writing to defendant of his infringement. Plaintiff prayed for an injunction against defendant and an accounting for profits and damages (Tr. 2-4).

The appellant by his answer denied committing any acts of infringement of Letters Patent 1,926,727; denied that Letters Patent No. 1,926,727 were duly and legally issued; affirmatively alleged that the patent in suit, and particularly claims 1, 2, 11, 15 and 17 thereof, are invalid and void in that each claim is for a non-patentable aggregation of old elements known, used, invented, described and published prior to the alleged invention or discovery thereof by Garner L. Knox, or more than two years prior to the date of filing of the application for said Letters Patent; affirmatively alleged that the device defined by the claims in suit was not novel or patentable at the time of the alleged invention thereof

by Garner L. Knox, but that said claims were and are invalid and void for the reason that devices covered thereby have been known, used, invented, described and published in publications and patents issued in this and foreign countries more than two years prior to the date of application for said Letters Patent, some of which are listed as follows: United States Patent No. 174,533 to Jeffries, issued March 7, 1876; United States Patent No. 177,156 to Richards, issued May 9, 1876; United States Patent No. 878,156 to Pratt, issued Feb. 4, 1908; United States Patent No. 915,733 to Brillie, issued March 23, 1909; United States Patent No. 924,862 to Warner, issued June 15, 1909; United States Patent No. 1,111,924 to Smith, issued Sept. 29, 1914; United States Patent No. 1,131,118 to Collard, issued March 9, 1915; United States Patent No. 1,147,439 to Pichoud, issued July 20, 1915; United States Patent No. 1,276,687 to Pflager, issued August 20, 1918; United States Patent No. 1,316,369 to Laisne, issued Sept. 16, 1919; United States Patent No. 1,414,147 to Naeser, issued April 25, 1922; United States Patent No. 1,436,031 to Furlong, issued Nov. 21, 1922; United States Patent No. 1,527,987 to McCracken, issued March 3, 1925; United States Patent No. 1,534,458 to Mohl, issued April 21, 1925; United States Patent No. 1,562,265 to Stebbins, issued Nov. 17, 1925; United States Patent No. 1,655,481 to Van Leuven, issued Jan. 10, 1928; United States Patent No. 1,692,891 to Fageol, issued Nov. 27, 1928; British Patent No. 8262 to Spencer, dated April 5, 1906.

As a further and separate answer and defense, appellant alleged that the claims in suit are invalid and

void because, in view of the state of the art and analogous arts, and in view of common knowledge of those skilled in the art, all as known at the time of and long prior to the alleged invention, the subject matter and disclosure of the patent in suit involved nothing more than the exercise of mechanical skill.

As a further and separate answer and defense, appellant alleged that the vehicle suspensions made and sold by him employ no construction in common with or equivalent to the structure defined by the claims in suit except such structures as are old and common property in the art and alike available to appellant and appellee (Tr. 6-13).

Jurisdiction of Court of Appeals.

This is a direct appeal from judgment of the District Court made on June 14, 1948, which was final except for accounting, decreeing that plaintiff is the owner of the entire right, title and interest in and to Letters Patent No. 1,926,727, granted September 12, 1933; that said Letters Patent are good and valid in law with respect to claims 1, 2, 11, 15 and 17 thereof which are the claims in suit; that defendant has infringed Letters Patent No. 1,926,727 and particularly claims 1, 2, 11, 15 and 17 thereof by the manufacture and sale of the FEATHER RIDE structure as exemplified by plaintiff's Exhibit 3-A and defendant's Exhibit 69; that plaintiff have judgment on its complaint for infringement of Letters Patent 1,926,727 as prayed for; directing the issuance of a permanent injunction perpetually restraining the defendant and those in privy with him from

using or selling or threatening to use or offering for sale or threatening to sell or contributing to the use of the combination patented in and by Letters Patent No. 1,926,727 and particularly claims 1, 2, 11, 15 and 17 thereof, or in anywise infringing the patent or upon the rights of the plaintiff under the patent; that the cause be referred to a special master for an accounting of the compensation due plaintiff and to determine attorney's fees to be allowed plaintiff in this cause; that the plaintiff have judgment and execution against defendant for costs (Tr. 25-29). Defendant filed motion for new trial on June 23, 1948 (Tr. 29-30), which was denied by the District Court in its order dated September 23, 1948 (Tr. 46). Thereafter, on October 8, 1948, defendant filed his notice of appeal to the Circuit Court of Appeals for the Ninth Circuit (Tr. 47), and thereafter duly perfected said appeal. Jurisdiction of the Court of Appeals rests upon Section 1292, Title 28, U.S.C.

STATEMENT OF THE CASE

In January, 1925, one Harry Y. Stebbins brought to Utility Trailer Manufacturing Company a form of six wheel attachment which he requested that company to manufacture for him on a time and material basis (Tr. 71). Mr. Stebbins had no drawings of his rocker arm type of attachment, and showed Mr. Knox by sketches what and how he wanted it built. Mr. Stebbins had made sales of a number of such attachments and wanted immediate delivery (Tr. 71). The attachment designed by Mr. Stebbins and brought by him to Utility Trailer

Manufacturing Company was substantially what is shown in Figure 1 of Letters Patent No. 1,926,727 "if you omit the universal [joint] on the end of the rocker arm and just make a connection there." (Tr. 75). The company permitted Mr. Stebbins to use shop facilities and the service of mechanics to build the attachment embodying his idea (Tr. 80). Mr. Stebbins personally directed mechanics employed by Utility Trailer Manufacturing Company how to build the attachment. Several of the attachments as designed by Mr. Stebbins were built (Tr. 80). Mr. Stebbins used a trade name for the attachment, termed "Simplex", to indicate that the attachment was simple and had few working parts.

The Stebbins attachment comprised a six wheel attachment for motor vehicles and is described as the combination of a [vehicle] frame having leaf springs connected at one end to the vehicle frame, detached from the vehicle [frame] at the opposite ends, or at their ends toward the axle of the attachment, for the purpose of being connected to the ends of rocker arms, hanger brackets secured to the frame, each rocker arm being pivotally supported by one of the brackets, a pin and bushing securing the rocker arm at opposite sides of the frame to the axle of the attachment, and wheels journaled on the axle (Tr. 114-115).

About thirty trucks were equipped with the Stebbins attachment (Exhibit No. 5). Knox was of the opinion that they would not properly perform the work intended, although apparently they were doing so. Mr. Knox believed that a universal or ball joint was required, but was not positive that the Stebbins construction, due to

the method of attaching the brackets to the axle, might not stand up sufficiently well to be satisfactory, and so did not insist on complicating the mechanism until his type had been put into service (Exhibit No. 5, p. 71). Mr. Knox suggested putting in a universal joint where the rocker arm attached to the axle bracket. Mr. Stebbins and Mr. Knox were in agreement that some universal action would be an improvement, but did not want to hold up manufacture of the attachments then in production (Exhibit No. 5, p. 6).

The Stebbins attachment was made during the period of February to April of 1925 (Tr. 76). About the end of April or early in May Mr. Knox first learned that some of the Stebbins attachments were showing excessive wear at the point where Figure 1 of the Knox patent shows the universal.

Utility Trailer Manufacturing Company negotiated with Mr. Stebbins to take over the manufacture and sale of the Stebbins attachment (Tr. 89), and subsequently, on May 21, 1925, an agreement was executed whereby Utility Trailer Manufacturing Company took over the entire business (Tr. 89). Utility Trailer Manufacturing Company paid Mr. Stebbins a royalty for the use of the invention until it bought out his rights entirely (Tr. 123).

In May, 1925, Mr. Garner L. Knox designed a universal connection which could be used for replacement purposes on trucks in operation which had been equipped with the Stebbins attachment and which were showing wear at the point of connection between the axle and the

rocker arm (Tr. 72). Plaintiff's Exhibits 6-B, 6-C and 6-D illustrate the first rocker arm built and installed with the universal joint (Tr. 113). This universal joint comprises bearings disposed at rights angles to each other (Tr. 114). The drawings are dated May 28, 1925.

Defendant stipulated that the Knox invention was conceived March 1, 1925, and was reduced to practice during the early part of June, 1925. Plaintiff accepted the stipulation (Tr. 132).

Utility Trailer Manufacturing Company equipped trailers of its manufacture with the tandem axle suspension (six wheel attachment) shown in the Knox patent from June, 1925 through 1927 or 1928, when it was discontinued (Tr. 104). Trailers now manufactured by Utility Trailer Manufacturing Company are equipped with a tandem axle suspension similar to that shown in the Stebbins and Van Leuven patent No. 1,562,265 (Exhibit No. 52), which structure utilizes a leaf spring over each of the tandem axles, the springs on each side of the vehicle being interconnected by a rocker arm. In the structure now in use the axles are journaled in bearings on which the springs are mounted, and the spring and the bearing for the axle together constitute a universal joint, so that there is a universal joint between each axle and the end of the rocker arm. Transverse tilting of the axle is taken by the springs (Tr. 105-106).

Mr. Harry Y. Stebbins filed application for United States Letters Patent, Serial No. 26,884, filed April 30, 1925, for the structure which is shown in Figure 1 of the Knox patent, except that he employed a pin and

bushing in place of the universal joint disclosed by Knox (Tr. 117). This application was involved in Interference No. 55,455, declared June 10, 1927, which also involved an application for Compensating Truck Springs, filed by Samuel B. Brown, Serial No. 140,958, and an application for Six Wheel Attachment for Vehicles, filed by David L. Van Leuven, Serial No. 9939. Judgment was entered against the party Brown for the reason that his alleged date of conception was subsequent to the filing dates of Stebbins and Van Leuven. Harry Y. Stebbins and Utility Trailer Manufacturing Company, assignee of the Stebbins application, conceded priority of invention to David L. Van Leuven, and consented that final judgment of priority be rendered in favor of said David L. Van Leuven. Priority of invention of the subject matter in issue was awarded to David L. Van Leuven (Tr. 45). The Harry Y. Stebbins application, Serial No. 26,884, was abandoned (Tr. 87). The David L. Van Leuven application, Serial No. 9939, matured as Letters Patent No. 1,655,481. The Stebbins attachment was covered by the Van Leuven patent, which has expired (Tr. 123). The Stebbins structure, which is similar in construction to the structure shown in Figure 1 of the Knox patent in suit, except that it does not employ the universal joint, is now free to anyone.

Mr. Garner L. Knox made application for United States Letters Patent, Serial No. 158,560, filed January 3, 1927, for Six Wheel Attachment for Motor Vehicles (Exhibit 20). The Knox application was involved in Interference No. 55,383, declared June 3, 1927, between said application and Letters Patent No. 1,620,809, grant-

ed March 15, 1927, to Albert H. Fager. The subject matter in issue was defined by counts which now appear as claims 12 and 13 of the Knox patent, which are not in issue in the instant case. Priority of invention was awarded to Garner L. Knox (Exhibit No. 5).

Mr. Knox described his invention as "a modified form of ball joint incorporated in the end of a rocker arm, one end of said rocker arm being connected to a truck spring, and the other end through this ball joint to a six wheel attachment axle." He described the purpose of a six wheel attachment as being "to distribute the load of the truck through four wheels on the rear end, instead of the customary two." The purpose of his specific invention was stated as "to permit independent movement of the wheels of the six wheel attachment relative to the frame of the truck." (Testimony of Garner L. Knox, Exhibit No. 5, p. 2).

The Knox application, Serial No. 158,560, issued as Letters Patent No. 1,926,727, the patent in suit. This suit, alleging infringement of the patent, involves claims 1, 2, 11, 15 and 17, which read as follows:

1. In a six wheel attachment for motor vehicles, the combination of a frame, a pair of hanger brackets secured to the frame, rocker arms pivotally supported by the brackets, means for securing one end of the arms to one end of the springs supporting the rear end of the frame, an axle, universal means for securing the axle at the opposite sides of the frame to the rocker arms, and wheels journaled on the axle.

2. In a six wheel attachment for motor vehicles, the combination of an axle, wheels journaled on the axle, a pair of rocker arms, means for pivotally

supporting the rocker arms intermediate their ends from the vehicle frame, universal swivel connecting means between the axle and one end of each rocker arm, and means for securing the opposite ends of the rocker arms to free ends of the rear springs of the motor vehicle.

11. The combination of a six wheel attachment for motor vehicles of a pair of combined radius and rocker arms, means for pivotally mounting the rocker arms, means for securing one end of each rocker arm to the free end of a spring of the motor vehicle and universal swivel means for securing the opposite end of the rocker arm to the axle of the attachment.

15. In a motor vehicle, an axle having wheels thereon, a frame, springs connected to said frame having one of their ends connected by links to rocker arms, means for pivotally mounting said rocker arms on said frame intermediate their ends, a second axle having wheels thereon, means for connecting said axle to said rocker arms, said means having means permitting said last named axle to have oscillatory movement relative to said rocker arms.

17. A vehicle comprising a frame, an axle, wheels on said axle, a spring mounted on said axle, a second axle, a rocker arm pivoted to said frame, means connecting said last mentioned axle and one end of said rocker arm including a universal joint and means connecting the other end of said rocker arm with said spring.

It is plaintiff's position that:

1. Insofar as distribution of the load is concerned, the front walking beam (Exhibits 3-A and 75) of defendant's Feather Ride suspension and the leaf spring 3 shown in Figure 1 of the Knox patent "are identical" (Tr. 94);

2. That the rubber cushion surrounding the T-casting affixed to the rear axle of the Feather Ride suspension is the equivalent of the universal joint shown and described in the Knox patent (Tr. 96-97); and

3. That the rear walking beam of the Feather Ride suspension corresponds to the rocker arm 8 of the structure shown in Figure 1 of the Knox patent (Tr. 102).

The plaintiff, Six Wheel Corporation, is a patent holding corporation organized in 1927, and was owned jointly by Six Wheels, Incorporated, and Utility Trailer Manufacturing Company. About 1930 or 1932, Utility Trailer Manufacturing Company bought out Six Wheels, Incorporated, so that at the present time Utility Trailer Manufacturing Company is the sole owner of Six Wheel Corporation (Tr. 121). Six Wheel Corporation owns the patent to Stebbins, No. 1,562,265, the patent to Van Leuven, No. 1,655,481, and the patent to Knox, No. 1,926,727.

DEFENDANT'S ALLEGED INFRINGEMENT DEVICE

The defendant's structure is a dual-beam, dual-axle suspension comprising interconnected front and rear walking beams, each carrying an axle for the road wheels of the vehicle. The front walking beam is pivotally connected at its forward end to the vehicle frame, and is pivotally connected at its rear end to the forward end of the rear walking beam. The rear walking beam supports a major proportion of the weight of the ve-

hicle on a trunnion intermediate the ends of the rear walking beam, with the rear axle attached near the rearward extremity of the beam. A resilient assembly comprising nested coil springs is arranged to support the vehicle frame on the rear walking beam trunnion. The various pivotal connections of the two walking beams and the connections between the walking beams and the axles are all rubber cushion mounted in a manner to provide an inherent resilience and flexibility in the system and to obviate the necessity for lubrication of any part of the system. Knox testified that the use of rubber to permit the universal action needed to maintain the required flexibility was a common manner of providing flexible action (Tr. 96). Pursuant to Mr. Knox's testimony in this regard, it is defendant's position that:

1. The use of springs or beams connected at one end to the vehicle frame and connected at their opposite ends to rocker arms for distributing the load to tandem axles, one such axle being mounted midway of the length of the beam or spring and the other such axle being connected to the end of the rocker arm, was known and invented prior to the date of invention by Knox of the alleged invention defined by the claims in suit, stipulated to be March 1, 1925. This use of springs or beams and rocker arms for distributing the load to tandem axles is clearly shown by the device which Mr. H. Y. Stebbins brought to Mr. Knox in January, 1925; by Letters Patent No. 878,156 (Exhibit 32); by Letters Patent No. 1,534,458 (Exhibit 51); Letters Patent No. 1,655,481 (Exhibit 56); and British Patent No. 8262 of 1906 (Exhibit 59).

2. The use of a universal joint as a means for attaching an axle to the free ends of rocker arms was known and invented prior to the date of invention by Knox of the alleged invention defined by the claims in suit, stipulated to be March 1, 1925. This use of a universal joint is clearly shown by Letters Patent No. 878,156 (Exhibit 32); Letters Patent No. 1,111,924 (Exhibit 38); Letters Patent No. 1,131,118 (Exhibit 39); Letters Patent No. 1,316,369 (Exhibit 45); Letters Patent No. 1,527,987 (Exhibit 50); and Letters Patent No. 1,692,891 (Exhibit 58).

SPECIFICATIONS OF ERROR

Appellant relies upon each of the errors assigned by him in the Statement of Points, filed December 22, 1948 in the District Court, as amended by striking therefrom paragraph numbered (6) (Tr. 53-56).

For convenience of the Court these assignments may be grouped and discussed by groups rather than individually.

Group I. Error of the District Court in holding claims 1, 2, 11, 15 and 17 of the Knox patent valid as not being anticipated by the prior art. Statement of Points, paragraphs numbered 2, 3, 4, 12, 13 and 17.

Group II. Error of the District Court in failing to find that each of claims 1, 2, 11, 15 and 17 of the Knox patent is invalid and void in that each of said claims defines a non-patentable aggregation of elements known, used, invented, described and published prior to March

1, 1925. Statement of Points, paragraphs numbered 3 and 16.

Group III. Error of the District Court in holding that defendant's structure, exemplified by Exhibits Nos. 3-A and 69, infringes claims 1, 2, 11, 15 and 17 of the Knox patent. Statement of Points, paragraphs numbered 1, 10, 11 and 14.

Group IV. Error of the District Court in holding that the alleged invention disclosed in the Knox patent was the sole invention of Garner L. Knox. Statement of Points, paragraphs numbered 7, 8, 9, 12 and 13.

Group V. Error of the District Court in failing and refusing to grant defendant's motion to amend his pleadings to include the defense of invalidity of Letters Patent No. 1,926,727 on the ground that the invention of the Knox patent in suit was not the sole invention of Garner L. Knox, but was a joint invention of Garner L. Knox and Harry Y. Stebbins. Statement of Points, paragraphs numbered 7 and 8.

Group VI. Error of the District Court in not finding that the subject matter defined by claims 1, 2, 11, 15 and 17 of the Knox patent did not involve patentable knowledge or invention, and involved nothing more than the exercise of mechanical skill. Statement of Points, paragraph 18.

Group VII. Error of the District Court in adopting the Conclusion of Law that plaintiff-appellee is entitled to a judgment for an injunction and accounting with costs and attorneys fees, and in rendering such judgment

and issuing a permanent writ of injunction. Statement of Points, paragraph 15.

POINTS AND AUTHORITIES ON ASSIGNMENTS OF ERROR GROUP I

A patent for a combination should be narrowly construed. The inventor is entitled only to a range of equivalents commensurate with the scope of his invention. A patentee is not entitled to a construction of his claims such that it will bring within their scope a construction which is more akin to the prior art than it is to the device of the patentee.

Brill v. Washington Railway Co., 215 U.S. 527;
54 L. Ed. 311; 30 S. Ct. 177.

*Elliott Machine Co. v. P. P. Appeldoorn's Sons
Co.*, 267 F. 983 (C.C.A. 6th Cir.).

Troy Wagon Works Co. v. Ohio Trailer Co., 272
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H. D. Hughes, et al. v. Magnolia Petroleum Co.,
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In re Au, 362 O.G. 4.

In re Kehl, 101 F. (2d) 193; 40 U.S.P.Q. 357; 26
C.C.P.A.; 502 O.G. 6.

ARGUMENT

About 1920 and following the first World War, the federal, state and local governments began an active program of construction of hard surfaced roads to keep pace with the increase in use of motor vehicles as a means of transportation, both for passengers and for

freight. There was a tendency to haul larger and larger loads, and this tendency soon outstripped the capacity of the roads. Persons in the business of hauling freight by motor vehicle, in an effort to increase their pay loads and net income return, were either inadvertently or deliberately increasing the loads to weights which taxed and exceeded the road capacity, and it became necessary to enact laws and ordinances limiting the load per wheel.

One obvious answer, both to the fundamental problem and to enable compliance with state laws and municipal ordinances, was to increase the number of wheels per vehicle. A standard solution was to provide an auxiliary axle with two additional wheels to convert four-wheel motor freight vehicles to six-wheel vehicles. A number of patents were issued throughout the years preceding the Knox invention, providing such six-wheel attachments. These prior art patents, listed below, as well as the Knox patent in suit, illustrate alleged inventions of this type, and the activity in the art at the time.

Exhibit No.	Patentee	Patent No.	Application filed	Patent issued
32	Pratt	878,156	Apr. 10, 1907	Feb. 4, 1908
35	Brillie	915,733	Nov. 7, 1907	Mar. 23, 1909
48	Furlong	1,436,031	May 9, 1921	Nov. 21, 1922
51	Mohl	1,534,458	Aug. 14, 1923	Apr. 21, 1925
52	Stebbins et al.	1,562,265	Feb. 23, 1924	Nov. 17, 1925
56	Van Leuven	1,655,481	Feb. 18, 1925	Jan. 10, 1928
58	Fageol	1,692,891	Apr. 23, 1923	Nov. 27, 1928
	Stebbins (Serial No. 26,884)		Apr. 30, 1925	
59	Spencer (British)	8,262		Apr. 5, 1906
1	Knox	1,926,727	Jan. 3, 1927	Sept. 12, 1933
(Conceived about Mar. 1, 1925)				

The problem of distribution of the load to four or more wheels of a vehicle and to enable the wheels to accommodate themselves to irregularities on the road surface, is quite old in the art, extending back at least to 1876, as exemplified by Patent No. 174,533, issued to Jeffries (Exhibit No. 30) for a car-truck; and also as illustrated in British Patent No. 8262 of 1906 to Spencer for improvements in bogies for railway vehicles and the like. Six-wheel motor vehicles are shown as early as 1908 in Patent No. 878,156, issued to Pratt (Exhibit No. 32).

Each of the above named prior art patentees, and Knox, have obtained a patent for a purported contribution to the art in the matter of overcoming incidental problems introduced in connection with the redistribution of the load from four wheels to six wheels.

The patentee, Knox, describes and classifies his invention in his patent (page 1, col. 1, lines 1-8) as follows:

“This invention relates to six wheel attachments for motor vehicles and is more particularly directed to a six wheel attachment for trucks, buses and the like, for distributing the load carried by the motor vehicle to the added wheels, to remove from the rear wheels of such motor vehicle a portion of the load customarily carried thereby.”

The only object specifically stated in the Knox patent (page 1, column 1, lines 21-28) is:

“to provide a six-wheel attachment for motor vehicles, which attachment includes a universal swivel connection between the axle of the six wheel attachment and the motor vehicle frame, so as to per-

mit the wheels to traverse the roadway and be maintained on the roadway irrespective of the road irregularities.”

Plaintiff-appellee contended in the lower court for the benefit of the doctrine of equivalents in reading claims of its patent on the defendant's structure, contending that the trunnion rubber bushing mounted in a journal box surrounding the axles of the defendant's structure was known to be the equivalent of the ball and socket universal joint illustrated in the Knox patent (Finding of Fact No. 10) (Tr. 21). Plaintiff's witness Knox testified that the following constructions were used as universal joints, or would provide universal action between the rocker arm and the axle of the attachment:

(1) In the **FEATHER RIDE** construction the T-casting, welded to the axle and surrounded by rubber to permit the axle to tip relative to the rocker arm (Tr. 96-97).

(2) Rubber is frequently used to provide for flexible action—as in a universal joint of an automobile (Tr. 96).

(3) A spring mounted on a journal which is free to turn on the axle is a universal connection, transverse tilting of the axle being taken by the springs (Tr. 106).

(4) A rubber block interposed between the rocker arm and the axle of the attachment would constitute a universal joint (Tr. 107).

(5) A complete ball joint (Tr. 109).

(6) A cylinder inside of a ball (Tr. 109).

(7) A leaf spring is the equivalent of a universal

joint (Tr. 113).

(8) The first universal joint embodying the Knox invention was made of bearings disposed at right angles to each other (Tr. 113-114).

Pursuant to this testimony, types of universal joints described by Mr. Knox are illustrated in the following Letters Patent, where they are shown as providing universal action between a rocker arm and an axle of an automotive vehicle in a six-wheel type of chassis for motor vehicles.

The patent to Fageol, No. 1,692,891, for which application was filed April 23, 1923, contains the following disclosure:

“As the vehicle travels along a road, one wheel may run over an elevation throwing one side of the axle upwardly and the connection between the bolster and the axle is such, that this action can take place without subjecting the bolster to strains. This is accomplished by inserting a block of resilient material 14, such as rubber, between the axle and the bolster. * * * The interposition of the block of conformable material, between the bolster seats 16 and the axle, also permits the axle to assume varying angular positions in the vertical plane, by deforming the blocks, without subjecting the bolster to strain.” (Tr. 557-558)

The patent to Pichoud, No. 1,147,439, (Tr. 507) shows springs mounted on journals which are free to turn on the axles. Pichoud says that this construction “will distribute the weight load or strain equally upon the springs and insure a smooth and even riding of the vehicle.” (Tr. 509). The patent to Brillie, No. 915,733,

(Tr. 487) shows rocker arms o-n pivotally connected to the springs for the rear axle, the springs being secured to the rear axle by means of a pivotal connection r'. Brillie states that a like pivotal connection as between each rear spring and the rear axle can be equally well applied to the intermediate axle i. The structure is provided to overcome difficulties encountered when a single wheel is vertically displaced by encountering an obstacle.

Pratt 878,156 (Tr. 480) shows a globular enlargement on the axle received in a ball bearing provided in the end of the lever 9.

In addition to the above, other forms of universal joints by means of which vehicle axles are secured to rocker arms are disclosed by the patents before the court, as follows:

A universal joint formed by bearings disposed at right angles to each other is shown in the patent to Collard, No. 1,131,118 (Tr. 503). Smith 1,111,924 (Tr. 497) discloses trunnions 17 mounted in bearings 18 disposed at right angles to the bearing for the axle 12. In the patent to Pflager 1,276,687 (Tr. 512), transverse tilting of the axle is provided in that the springs 16 are mounted for rocking movement upon suitable bearing blocks 18, the latter being positioned on the journal boxes 14 for the axles. Laisne 1,316,369 (Tr. 519) discloses a rocker arm c pivotally mounted on the frame b² and having means for securing one end of the rocker arm to one end of the spring supporting the rear end of the frame, and an enclosed ball joint for securing the op-

posite end of each rocker arm to the corresponding axle. The patent to Naeser 1,414,147 (Tr. 524) discloses another form of universal joint provided by bearings disposed at right angles to each other. In Furlong 1,436,031, (Tr. 528) the axles 28 and 34 are connected to the ends of rocker arms 4 by universal means comprising a chain. In this patent the bracket 2, equalizing bar 4, chain 36, chain 33 and springs 31 and 35 supply the elements called for by the claims of the patent in suit, which read:

“a pair of rocker arms, means for pivotally supporting the rocker arms intermediate their ends from the vehicle frame, universal swivel connecting means between the axle and one end of each rocker arm, and means for securing the opposite ends of the rocker arms to free ends of the rear springs of the motor vehicle.”

In the patent to McCracken, et al., 1,527,987, (Tr. 534) the universal joint takes the form of a bearing for the rear axle 12 provided with studs 22 which are journaled in the yoke 21. The patent to Stebbins, et al., 1,562,265 (Tr. 542) illustrates a construction wherein transverse tilting of the axle is taken by the springs. The patent to Van Leuven 1,655,481 (Tr. 547) illustrates another construction in which transverse tilting of the axle is taken by the springs. Note that claims 11 and 12 of the Van Leuven patent read on the structure illustrated in Figure 1 of the Knox patent in suit. Should appellee object that claim 11 calls for a *spring* in place of the rocker arm, it must be remembered that Knox testified:

“As far as distribution of the load is concerned, a beam and a spring are identical.” (Tr. 94)

Also that:

“Transverse tilting of the axle is taken by the springs.” (Tr. 106)

It should be remembered that Mr. Knox testified that these elements, which appellant has found illustrated in the prior art, are equivalents of the universal joint employed in the Knox structure. It should likewise be remembered that in the patents to Pratt 878,156; Brillie 915,733; Pflager 1,276,687; Furlong 1,436,031; Stebbins, et al., 1,562,265; Van Leuven 1,655,481; Fageol 1,692,891; and British 8262 of 1906, these elements are employed in vehicle suspensions as universal swivel connecting means between rocker arms and axles for the purpose of providing flexibility in the distribution of the load from four wheels to six wheels.

The patent to Brillie 915,733 shows a six wheel attachment for motor vehicles in which the axle of the attachment is connected to the rocker arm on by means of a leaf spring and pivoted connection. The patents to Smith 1,111,924, Collard 1,131,118, Laisne 1,316,369, and McCracken, et al., 1,527,987, each illustrates a universal connection between the rocker arm and the vehicle axle, the opposite ends of the rocker arms being secured to free ends of the springs of the vehicle. The patent to Van Leuven 1,655,481, for which application was filed February 18, 1925, covers a six wheel type of chassis in which an attachment is provided for converting a four wheeled vehicle into a six wheeled vehicle.

The patent structure was prior to Knox, the application having been filed prior to the date of conception of the Knox invention. In *Six Wheel Corporation v. Sterling Motor Truck Co. of California*, 40 F. (2d) 311, the plaintiff corporation, as assignee of Patent No. 1,655,481, sought an injunction and damages against defendants for alleged infringement of said Letters Patent. The claims in issue were the tenth and twelfth claims of the patent. District Judge McCormick said:

"The main contention of complainant is that these claims should be given broad construction because of the advance in the art that was wrought by Van Leuven in the invention covered by the patent herein. I cannot agree with this contention. * * * Of course, if the invention is in fact generic, and if the patent, in view of the state of the prior art, should be raised to the dignity of a pioneer patent, then the claims thereof should be broadly interpreted and construed so as to render to the inventor all legitimate fruit of his concept, but, in my opinion, no such construction is justified in this suit, in view of the prior patents submitted in evidence and in view of the conduct of Van Leuven in participating in an application for patent that was issued to him and one Stebbins November 17, 1925, being No. 1,562,265, for a six wheel truck.

"It is clear to me, in view of Lewis 865,599, Brillie 915,733, Warner 924,862, Furlong 1,454,162, and Stebbins and Van Leuven 1,562,265, that claims 10 and 12 are not entitled to broad construction so as to read upon any device that the evidence in this case shows to have been manufactured, sold or used by any of the defendants herein. I think that Van Leuven and his assignee are not shown to be entitled to completely monopolize the six wheel running gear attachment field because of the grant of the patent in suit. The prior art is such that complainant should be restricted to the specific

devices and combinations shown by the drawings and specifications of the patent in suit and, in such event, neither of the claims sued on read upon the structures or attachments of defendants, as shown by the evidence herein."

To summarize: The patentee Knox did not invent a six wheel attachment for motor vehicles: all of the structure shown in Figure 1 of the patent in suit, with the exception of the universal joint, had been presented to Knox by Harry Y. Stebbins. Knox did not invent a universal joint: The first universal joint which he used in the Stebbins structure was in the form of bearings disposed at right angles to each other as in Collard 1,131,118. Knox admits that a number of other elements would provide the required oscillatory movement: and appellant directs attention to the fact that each of the named elements was disclosed by prior art patentees for the purpose of providing flexibility of movement between the free end of the rocker arm and the axle of the attachment in a six wheel type chassis.

POINTS AND AUTHORITIES ON ASSIGNMENTS OF ERROR GROUP II

The first negative rule of invention is that it does not involve invention to utilize an element or expedient which is old in the same or in an analogous art, unless the old element or expedient, in its new environment, performs some distinctly new function, or is the cause of some distinctly new and useful result or advantage.

E. Clemens Horst Co. v. Gibbens & Blodgett, et al., 50 F.S. 607; 57 U.S.P.Q. 367.

In re Cook, 134 F. (2d) 494; 57 U.S.P.Q. 120.

Willamette Hyster Co. v. Pacific Car & Foundry Co., 122 F. (2d) 492; 50 U.S.P.Q. 422.

Grinnel Machine Co. v. Johnson Co., 247 U.S. 426, 432.

Samuel Eagle, et al. v. P. and C. Hand Forged Tool Co., 74 F. (2d) 918; 24 U.S.P.Q. 181.

Dallas Machine & Locomotive Works, Inc. v. Willamette Hyster Co., et al., 112 F. (2d) 623; 46 U.S.P.Q. 12.

Lincoln Co. v. Stewart Warner Corp., 303 U.S. 545; 37 U.S.P.Q. 1.

Hailes v. Van Wormer, 87 U.S. (20 Wall.) 353.

One who merely substitutes an element in a combination invented by another may not claim the combination.

Willamette Hyster Co. v. Pacific Car & Foundry Co., et al.; *Pacific Car & Foundry Co. v. Willamette Hyster Co.*, 122 F. (2d) 492; 50 U.S.P.Q. 422.

Thomas & Betts Co., et al. v. Steel City Electric Co., 122 F. (2d) 304; 50 U.S.P.Q. 230.

Timken Detroit Axle Co. v. Cleveland Steel Products Corp., 148 F. (2d) 267; 65 U.S.P.Q. 76.

ARGUMENT

The patentee Knox acknowledges that the conception and reduction to practice of the Stebbins structure was prior in time to the Knox invention. Knox's sole contribution to the device claimed in his patent was the substitution of a modified universal joint for the simple hinge link of Stebbins for securing the rocker arm to

the axle of the attachment. Knox concedes that the universal joint per se was old and well known in the art. Also, he names a considerable number of elements which he says are equivalent to a universal joint, each of which, likewise, was old and well known in the art at the time of the Knox invention. Moreover, the patents to Pratt 878,156, Brillie 915,733, Pflager 1,276,687, Furlong 1,436,031, Stebbins, et al. 1,562,265, Van Leuven 1,655,-481, Fageol 1,692,891, and British 8262 of 1906, each discloses the use of a universal joint or equivalent means between a rocker arm pivotally mounted on the vehicle frame and the axle of the attachment.

No novel idea was developed in combining the Stebbins structure and the particular universal joint selected by Knox, and Knox made no patentable invention, irrespective of the worth of the improvement.

The manner of securing a vehicle axle to the free ends of rocker arms by means of universal joints, and the reason for so doing, is disclosed and taught by the patents to Smith 1,111,924, Collard 1,131,118, Laisne 1,316,369, and McCracken, et al. 1,527,987. Since most of the elements were already in combination and already well known, singly or in groups, as common expedients in similar situations, the substitution for the simple hinge link of any one of the several forms of universal joints familiar to mechanics for analogous use, can hardly be said to justify the patent. The combination of the Stebbins structure and the universal joint did not produce some new result going beyond that which may have been achieved by mere mechanical skill in operating the elements disclosed by the prior art. In

fact, the required teaching is to be found in any of the patents covering a six wheel type chassis in which a universal joint or an equivalent structure is provided between the axle of the six wheel attachment and the motor vehicle frame.

The claims in suit define the invention as "in combination" all of the elements of the structure brought to Knox by Stebbins, except that in place of the simple hinge link provided by Stebbins between the rocker arm and the axle of the attachment Knox substituted a "universal swivel means" to provide for greater flexibility of movement of the parts connected thereby.

In the case of *E. Clemens Horst v. Gibbens & Blodgett, et al.*, supra, it being determined that a separator belt was the only element invented by the patentee, District Judge Welch of the District Court N. D. California, N. Div., held the patent invalid, saying:

"The claim of the separator patent did not cover the separating belt alone. The separating belt was one of a combination of elements none of which performed any new or different function in the claimed combination over that performed by these same elements as shown in combination in the expired patent to Horst No. 1,054,119."

Holding invalid a patent claiming a combination in a mining drill coupling of old elements and the patentee's improved latch, the Court of Customs and Patent Appeals, in *In re Cook*, 57 U.S.P.Q. 120; 134 F. (2d) 494, stated:

"Appellant claims to have made an improvement in the particular kind of bolt or latch device which

goes into the hole or well. The improvement, obviously, is not in a new combination. His improvement fits into the combination in the same manner as other latch or bolt devices fit into the combination. As a combination, he obtains no new results, and *if he otherwise obtains any new result, it flows from his latch improvement*. The old elements of the combination perform their function in the same old way. There is no new co-action between parts of the combination."

In *Timken-Detroit Axle Co. v. Cleveland Steel Products Corp.*, 65 U.S.P.Q. 76; 148 F. (2d) 267, the Circuit Court of Appeals, Sixth Circuit, held that Powers' substitution of metal for a ceramic rim in an oil burner did not justify his claim to the entire combination:

"At most the claimed invention is merely the improvement of one element of an old combination the construction and operation of which are otherwise unchanged, and does not entitle the patentee to a repatent of his old invention by claiming that an improved element is substituted for an old element."

Similarly, Knox merely provided an improved connection to replace the simple hinge link connection in the Stebbins structure, the remaining elements of the combination performing no new function.

In *Willamette-Hyster Co. v. Pacific Car and Foundry Co.*, 50 U.S.P.Q. 422; 122 F. (2d) 492, the Circuit Court of Appeals, Ninth Circuit, observed that Wickes and Neil averred, in their disclaimer to certain matter in their patent, that they did not invent the combination shown in Meister's patent, but, notwithstanding, claimed

the entire combination with one element substituted. The Court stated:

“To thus concede the invention of a combination to have been made by another and, nevertheless, to claim the entire combination with the substituted element invalidated the patent claim, under the rule announced in *Rogers, et al. v. Alemite Corp.*, 298 U.S. 415 (29 U.S.P.Q. 311), and reasserted in *Lincoln Engineering Co. v. Stewart-Warner Engineering Corp.*, 303 U.S. 545 (37 U.S.P.Q. 1).”

From Knox's testimony it is clear that he recognizes Stebbins' prior conception of the structure claimed in his patent with the exception of the substitution of a universal swivel connection for the simple link connection.

Circuit Judge Jones of the Circuit Court of Appeals, Third Circuit, in the case of *The Thomas & Betts Co., et al. v. Steel City Electric Company*, 50 U.S.P.Q. 230; 122 F. (2d) 304, held invalid claims for a combination with an armored cable of an insulating bushing and a connector. He stated:

“What Fullman did was to make a slight change (an improvement, it may be allowed) in the outer end of the connector. But that is not the invention for which he makes claim. By substituting his connector, he seeks to extend his monopoly to an invention of all the elements in combination. This he may not do unless his improved element and the other old elements in combination perform a new and useful function or operation. A patentee may not, merely by improving one element of an old combination whose construction and operation are otherwise unchanged and which performs no new or different use or function, patent the old combination by claiming it in combination with the im-

proved element. *Bassic Mfg. Co. v. R. M. Hollingshead Co.*, 298 U.S. 415, 425 (29 U.S.P.Q. 311, 315, 316); *Stewart-Warner Corp. v. Rogers*, 104 F. (2d) 762, 763 (40 U.S.P.Q. 391, 392) (C.C.A. 3)."

Mr. Knox improved upon the simple link connection in the Stebbins structure and then claimed as his invention the entire structure by incorporating his improved link (a modified universal joint) therewith.

In *Lincoln Engineering Co. of Illinois v. Stewart-Warner Corp.*, 37 U.S.P.Q. 1; 303 U.S. 545, the Supreme Court of the United States held invalid claims to a combination of a lubricant compressor, a coupling member and a headed nipple, said combination being adapted for lubricating automotive bearings. Mr. Justice Roberts, in delivering the opinion of the Court, stated the case to be similar to that of *Rogers v. Alemite Corp.*, reported with *Bassick Mfg. Co. v. Hollingshead Co.*, 298 U.S. 415 (29 U.S.P.Q. 311), and the decision therein applied here. It was stated thus:

"The invention, if any, which Butler made was an improvement in what he styles in his specifications the 'chuck' and in claim a 'coupling member'. * * * As we said of Gullborg in the *Rogers* case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with other old elements which performed no new function in his claimed combination. The patent is, therefore, void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in com-

bination with other old parts which perform no new function in the combination.” (citing many cases)

The decision of the Circuit Court of Appeals, Ninth Circuit, in *Dallas Machine & Locomotive Works, Inc. v. Willamette Hyster Co., et al.*, 112 F. (2d) 623; 46 U.S. P.Q. 12, furnishes an outline of the manner in which the claims in suit may be read on the prior art. Taking claim 1 of the Knox patent as the example, and following the procedure adopted by Circuit Judge Haney, we arrive at the following conclusions:

The claim introduces the subject matter as being: “In a six wheel attachment for motor vehicles”: We need look no further than the structure brought by Harry Y. Stebbins to Mr. Knox in January, 1925, and which is illustrated in Figure 1 of the drawings of the Knox patent, save that Knox has substituted a modified universal joint where Stebbins had employed a simple hinge pin.

The combination of a frame.

All of the motor vehicles in the prior art have “a frame”.

A pair of hanger brackets secured to the frame.

These are the brackets upon which the rocker arms are pivotally supported. All of the patents relied upon by appellant on appeal illustrate and describe brackets secured to the frame and upon which rocker arms are pivotally supported.

Rocker arms pivotally supported by the brackets.

Each of the patents relied upon by appellant illus-

trates and describes a rocker arm pivotally supported by hanger brackets secured to the vehicle frame.

Means for securing one end of the arms to one end of the springs supporting the rear end of the frame.

In the structure illustrated in the patent to Knox this element is the spring hanger 9 by which the rocker arm 8 is pivotally secured to the forward free end of the spring 3. A similar element, or the full mechanical equivalent thereof, is illustrated and described in each of at least *sixteen of the patents hereinabove referred to and relied upon by appellant on appeal.

An axle.

This is the axle of the attachment, and in the structure illustrated by Knox is the axle 10 or, in the modification illustrated in Figure 7, the axle 10a. Such an axle (in a six wheel attachment for motor vehicles) is illustrated in the patents to Furlong 1,436,031, Mohl 1,534,458, Stebbins 1,562,265, Van Leuven 1,655,481, British 8262 of 1906.

Universal means for securing the axle at the opposite sides of the frame to the rocker arms.

Each of the patents to Pratt, Smith, Collard, Pichoud, Laisne, Naeser, McCracken and Van Leuven illustrates and describes "universal means" for securing the axle at opposite sides of the frame to rocker arms; and in each instance the "means" employed has been described by plaintiff's witness Knox as being the full equivalent of a universal joint. Moreover, the patentees listed describe these "universal means" as performing the same

*The patents to Pratt and Fageol do not disclose this particular element.

function as claimed for the universal joint in the Knox patent.

In Brillie the rear axle is secured to the rocker arm by means of the rear spring and a pivotal connection. In Furlong the axle is secured to the rocker arms by means of leaf springs and chain links. In Stebbins, et al., and in Van Leuven the axle is secured to the rocker arms by means of leaf springs.

The universal joint illustrated in the Knox patent performs no different function than it does in any of the structures illustrated by the patentees listed in the immediately preceding paragraphs. Its sole purpose is as expressed by various ones of those patentees:

Pratt: "provides a flexible and to a limited extent universal joint or bearing as between the rear end of the side lever 9 and the rear axle."

Smith: "if one wheel only rises over a lump on the roadway, the axle can freely tip at that end without strain on the lever 8, the trunnion 17 permitting this movement."

Collard: "The swivel connections between the long arms of the bell cranks and the axles permit any of the wheels rising independently of the others without causing any torsional strain."

Laisne: "The outer end of each lever c is connected by means of a universal joint, for instance an enclosed ball joint, to the corresponding axle."

Naeser: "The spring 5 prevents longitudinal movement of the axle, but otherwise the latter has universal movement."

McCracken: "provide a universal joint connection between the levers abutting one of such springs and the axle."

Fageol: "one wheel may run over an elevation throwing one side of the axle upwardly * * *. This is accomplished by inserting a block of * * * rubber between the axle and the bolster."

As stated by Circuit Judge Haney, in *Dallas Machine & Locomotive Works, Inc. v. Willamette Hyster Co.*, supra:

"We believe, therefore, that the applicable rule is the one stated in *Lincoln Co. v. Stewart-Warner Corp.*, 303 U.S. 545, 549 (37 U.S.P.Q. 1), that the mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention'. The rule is more fully stated in *Hailes v. Van Wormer*, 87 U.S. (20 Wall.) 353, 368, as follows:

'It must be conceded that a new combination, if it produces new and useful results, is patentable, though all the constituents of the combination were well known and in common use before the combination was made. But the results must be a product of the combination, and not a mere aggregate of several results, each the complete product of one of the combined elements. Combined results are not necessarily a novel result, nor are they an old result obtained in a new and improved manner. Merely bringing old devices into juxtaposition, and there allowing each to work out its own effect without the production of something novel, is not invention. No one by bringing together several old devices without producing a new and useful result, the joint product of the elements of the combination and something more than an aggregate of old results, can acquire a right to prevent others from using the same devices, either singly or in other combinations, or, even if a new and useful result is obtained,

can prevent others from using some of the devices, omitting others, in combination.' ”

From a consideration of the decisions cited above, the position of the courts is clear, and it is generally acknowledged that the improvement of one part or element of an old combination gives no right to claim that improvement in combination with other old parts or elements which perform no new function in the combination. In the case under consideration, Mr. Knox has testified that his contribution to the improvement of the Stebbins six wheel attachment is the substitution of a universal connection for the simple link provided by Stebbins. Thus, it appears clear that Knox's "invention" is not in the *combination* of elements but rather in the improvement of a single element of the combination by reason of his substitution therefor of a universal joint. It is submitted that the claims of the Knox patent in suit should have been limited to his improvement and that, since he was not the inventor of the combination claimed, the patent is void as claiming more than the patentee invented.

POINTS AND AUTHORITIES ON ASSIGNMENT OF ERRORS GROUP III

That defendant's machine accomplishes the same result as complainant's patented device does not show infringement, where there is a variation in the means used.

Stebler v. Porterville Citrus Ass'n, 248 F. 927.
Petroleum Rectifying Co. of Calif. v. Reward Oil Co., 260 F. 183.

Diamond Power Specialty Co. v. Merz Capsule Co., 276 F. 274.

Superior Skylight Co. v. Zerbe Const. Co., 5 F. (2d) 982.

Stoehrer & Pratt Dodge Corp. v. Lusse Bros., 7 F. (2d) 87.

Automatic Appliance Co. v. McNiece Motor Co., 20 F. (2d) 578, 583.

Fairbanks, Morse & Co. v. American Valve & Meter Co., 31 F. (2d) 103.

Craftint Mfg. Co. v. Baker, et al., 94 F. (2d) 369; 36 U.S.P.Q. 164.

If a patent reads upon an offending apparatus infringement is suggested, although not proved, but there is no infringement if the claim will not read upon that which is said to infringe.

Goeghegan v. Ernst, 256 F. 670.

Tostevin-Cottie Mfg. Co. v. M. Ettinger Co., Inc., 254 F. 434.

That parts of defendant's machine and of plaintiff's machine are not interchangeable indicates non-infringement.

Diamond Match Co. v. Sun Match Corp., 16 F. (2d) 1.

Auto Hone Co. v. Hall Cylinder Hone Co., 3 F. (2d) 479.

If defendant's activities fall within the scope of the prior art he cannot be regarded as an infringer of plaintiff's patent.

Ingersoll Steel & Disc. Co. v. Budd Wheel Co., 67 F. (2d) 753; 19 U.S.P.Q. 231.

Eastman Oil Well Survey Co. v. Sperry-Sun Well Surveying Co., (C.C.A. 5) 131 F. (2d) 884; 56 U.S.P.Q. 5.

ARGUMENT

Comparison of Plaintiff's and Defendant's Devices.

The device illustrated in the patent in suit comprises leaf springs 3, each having one end secured to the vehicle frame 1 by any suitable means such as a spring hanger, and being detached from the vehicle frame at the opposite end, or at its end toward the axle of the attachment, for the purpose of being connected to the end of a rocker arm 8. Hanger brackets 6 are secured to the frame and pivotally support the rocker arms. The rocker arms are connected at one end to the springs 3 and at the other end to the axle of the attachment by a universal joint between the end of each rocker arm and the axle. In Figure 1 of the patent in suit, the rocker arm is not attached directly to the axle of the attachment, a yoke 15 being interposed therebetween.

Defendant's device comprises a front walking beam pivotally attached at one end to the frame of the vehicle and having its other end connected to the forward end of the rear walking beam by means of shackle links. Midway of the length of the front walking beam an axle is secured to the beam by means of a T-casting. The vertical portion of the T-casting is welded to the axle and the cross-arm of the T-casting is received in a housing in the mid portion of the beam where it is mounted in rubber. Two thirds of the length of the

rear walking beam is a trunnion as an integral part of the rear walking beam. Mounted on this trunnion is a spring rider on which are supported nests of coil springs and a snubber. The upper end of the coil springs and the snubber are received into brackets secured to the frame. A second axle is secured to the rear end of the rear walking beam by means of a T-casting welded to the axle and received in the housing in the walking beam where it is mounted in rubber.

In the Knox structure the means for distributing the load customarily carried by the rear wheels 4 to an auxiliary pair of wheels 5 comprises a pair of hanger brackets 6 which pivotally support rocker arms 8. Spring hangers 9 secure one end of each rocker arm to the forward free ends of the springs 3. To add the six wheel attachment embodying the Knox invention to a vehicle, one end of the rear spring on each side of the vehicle is detached from the vehicle and secured by means of spring hangers to one end of a rocker arm. The rocker arm on each side of the vehicle is pivoted intermediate its ends upon hanger brackets, the end of the rocker arm opposite the spring hanger 9 being connected to the axle of the attachment by a universal swivel connection.

Exhibit 75 shows the construction and mode of operation of defendant's FEATHER RIDE suspension. A single axle suspension consists of the rear walking beam and coil spring assembly, the forward end of the beam being connected to the vehicle frame by means of the front bracket A. When the single axle suspension is converted to tandem axle suspension, the forward end

of the rear walking beam is detached from bracket A, the front bracket A is removed and the forward end of the rear walking beam is connected to one end of the front walking beam. The forward end of the front walking beam is connected to the vehicle frame by means of a bracket. The axle of the attachment is mounted midway of the length of the front walking beam.

Plaintiff's witness Knox testified that as far as distribution of the load is concerned a beam and a spring are identical (Tr. 94). Mr. Knox testified that the front walking beam of the FEATHER RIDE suspension is the equivalent of the leaf spring 3 in the Knox structure (Tr. 101) saying: "The front beam is identical in lever action to the spring 3" (Tr. 102). Mr. Knox further testified that the blocks of rubber surrounding the T-head within the housings provided in the walking beams "permits the axle to tip relative to the walking beam" and so provides "universal action" (Tr. 96-97).

In other words, Mr. Knox testified that plaintiff's and defendant's devices *function alike* by reason of the fact that either a spring or a beam may be employed to distribute the load to the tandem axles, and the further fact that the rubber blocks which surround the T-casting in the housings in the walking beam "permit the axle to tip relative to the walking beam". Defendant's witness Alden W. Mackie testified that *in operation* the FEATHER RIDE structure and the Knox structure are alike (Tr. 142).

Notwithstanding that the operation of plaintiff's and defendant's devices are alike in that in each the load

carried by the vehicle is distributed to the wheels mounted on tandem axles and the rubber blocks permit the axles to tip relative to the walking beams, nevertheless there is a considerable variation in the elements employed in the two structures. Defendant's front walking beam is not a *spring*. Under maximum load of 27,000 pounds, the front walking beam of the FEATHER RIDE suspension was deflected only five-sixteenths inch (Exhibit 22—measurement "B" between axle beam and the bed of testing machine).

In the FEATHER RIDE suspension springing of the vehicle is provided by the nests of coil springs supported by the spring riders which rest on trunnions intermediate the ends of the rear walking beams. Notwithstanding that Mr. Knox testified that the front walking beam in the FEATHER RIDE structure is a spring, he testified also that the FEATHER RIDE structure, minus the coil springs, would not be permitted on highways in most states. He stated that if the coil springs were removed from the FEATHER RIDE suspension there would be no springs in the suspension (Tr. 126). It is clear, therefore, that his testimony to the effect that the front walking beam of FEATHER RIDE is a spring was in error.

Plaintiff's witness Knox and defendant's witness Alden W. Mackie both testified that the rear walking beam and spring cluster mounted on the rear walking beam in the FEATHER RIDE suspension is the equivalent of a leaf spring (Tr. 95 and 149); and that in converting a single axle suspension to a dual axle suspension, a rigid [front] walking beam is added, as illus-

trated on Exhibit 75. Plaintiff failed to establish that defendant ever manufactured, sold, or authorized the use of a structure in which the rear walking beam of the FEATHER RIDE suspension was connected to a spring.

In the Knox structure, one end of the rocker arm 8 is connected to spring 3, and the other end is connected to the axle of the attachment. The rocker arm 8 is pivoted midway of its length and its ends are free to follow movement of the axle as the wheels follow the contour of the roadway. In the FEATHER RIDE suspension, since the rear walking beam and spring cluster is the equivalent of a leaf spring, only the front walking beam can correspond to the rocker arm of the Knox structure, and it will be noted that the forward end of the walking beam is attached to the vehicle frame and hence is not free to follow movement of the axle in response to the changing contour of the roadway.

The actual mechanical operation of the FEATHER RIDE suspension is not similar to that of the Knox structure. The two devices perform the same function, in that each operates to distribute the load carried by the vehicle to the tandem axles. However, due to differences in construction and arrangement of parts, as for example the fact that the FEATHER RIDE structure employs the rigid rear walking beam and trunnion-supported nests of coil springs in place of the simple leaf spring 3 of the Knox structure, and the further fact that in the Knox structure the rocker arm is pivoted midway of its length, whereas in the FEATHER RIDE suspension the front walking beam is pivoted at its forward

end, there is a difference in mode of operation to which defendant's witness Mackie testified (Tr. 143).

Interchangeability of parts.

To interchange the front walking beam of the FEATHER RIDE suspension with the rocker arm of the Knox six wheel attachment would result in an inoperable structure. The front walking beam of the FEATHER RIDE suspension is pivotally connected at its forward end to the vehicle frame, whereas in the Knox patent the rocker arm 8 must be mounted for pivotal movement about a pin midway of its length. Because of this difference in structure, if the front walking beam of the FEATHER RIDE suspension were to be substituted for the rocker arm of the Knox structure, the interconnected ends of the walking beam and the leaf spring would move in the same direction, and the frame of the vehicle would drop down until stopped by the axles of the vehicle (Tr. 144). It would require a complete reorganization of the parts to substitute the front walking beam of the FEATHER RIDE suspension for the rocker arm 8 in the Knox six wheel attachment (Tr. 145).

Defendant's activities fall within the scope of the prior art.

Certain of the patents which are before this court as exhibits disclose structures which are in all respects similar to the FEATHER RIDE suspension. One of these is the patent to Pratt 878,156, and a comparison of Figure 2 of the patent drawings with the lowermost

illustration on Exhibit 75 will disclose this similarity. Pratt provides side levers 9 to which the rear axle 13 is secured by means of a universal joint. A leaf spring 8 is mounted on each lever 9. [Mr. Knox testified (Tr. 95) that the coil spring of the FEATHER RIDE suspension is the equivalent of a leaf spring.] The forward end of the lever 9 in the Pratt structure is connected to the foremost of the rear axles by means of a shackle consisting of interlocking clevises engaging with the axle and the forward end of the side levers 9, respectively. The reach 25 functions as a radius rod and "serves to hold the axle 17 against a tendency to rotate in conjunction with the axle 20". The side levers 9 of the Pratt structure are, for all intents and purposes, equivalents of the rear walking beams of the FEATHER RIDE structure. One of the interlocking clevises is equivalent to the shackle links which interconnect the walking beams in the FEATHER RIDE suspension. The other of the interlocking clevises forms a rocker arm, pivoted at one end, and carrying universal swivel means for securing the axle to the clevis.

An even closer approximation of the FEATHER RIDE suspension is illustrated in Figure 1 of the British patent to Spencer 8262 of 1906. If comparison is made with the lowermost illustration on Exhibit 75, it will be discovered that each element of the FEATHER RIDE suspension is duplicated by an equivalent element in the British structure. In each of the two illustrations the right hand end of the frame is broken away to indicate that the forward end of the frame is toward the right hand edge of the sheet. In each structure the forward

end of a solid front walking beam is pivotally secured to the vehicle frame. The foremost of the rear axles is mounted midway of the length of the walking beam, and in each instance the means of attachment of the axle to the walking beam is such that a universal swivel connection is achieved. The rearward end of the front walking beam is connected to the forward end of a rear walking beam by means of a flexible connection. In the **FEATHER RIDE** suspension the connection between the front and rear walking beams is by means of shackle pins mounted in rubber. In the British structure the connection takes the form of a pivoted hanging bolt q on which a spring d is threaded which supports the free end of the rear walking beam. In the **FEATHER RIDE** suspension the rear walking beam is a solid beam and is pivoted intermediate its length by means of the trunnion on which is mounted the spring rider. In the British structure the rear walking beam is in the form of a laminated spring which is pivoted intermediate its length on pin n . The universal swivel connection between the rear axle and the rear walking beam in the British structure is similar to the connection between the foremost axle and the front walking beam. In the **FEATHER RIDE** suspension each of the axles is connected to the respective walking beams by the T-casting and rubber filled housing hereinbefore described. Defendant's witness Mackie testified that the mode of operation of the British suspension and the mode of operation of the **FEATHER RIDE** suspension is substantially the same (Tr. 147).

Should the court be persuaded that the testimony of

plaintiff's witness Knox was correct when he stated that the front walking beam of the **FEATHER RIDE** suspension is a spring, then and in that event appellant invites attention to the structure illustrated and described in the patent to Mohl 1,534,458. The front walking beam of the **FEATHER RIDE** is pivotally connected at its forward end to the vehicle frame, and is connected at its rearward end to a rear walking beam. The foremost of the rear axles is mounted midway the length of the front walking beam. In the Mohl structure, the spring *a* is pivotally connected to the vehicle frame at *b* and is flexibly connected to the rear walking beam at *c*. The foremost of the rear axles *m* is mounted midway of the length of the spring. [Plaintiff's witness Knox testified that a leaf spring is the equivalent of a universal joint (Tr. 112-113 and 127).]

In both the Mohl structure and the **FEATHER RIDE** suspension the rear walking beam is in the form of a rigid beam, and in each instance the beam is pivoted intermediate its ends with the rear axle mounted on the free end of the beam.

Should the court find it to be true that a leaf spring and a beam are equivalent structures, and that in the **FEATHER RIDE** suspension the front walking beam is the equivalent of the spring 3 in the Knox structure (Tr. 101); and should the court likewise find it to be true that a leaf spring is the equivalent of a universal joint, then it is respectfully submitted that in the Mohl patent is to be found a disclosure of the combination of elements or their equivalents employed in the

FEATHER RIDE suspension. It follows as a matter of law, therefore, that if the FEATHER RIDE suspension infringes the claims of the Knox patent in suit, then by the same token the patent to Mohl 1,534,458 is a complete anticipation of the structure defined by those claims.

POINTS AND AUTHORITIES ON ASSIGNMENT OF ERRORS GROUP IV

In order to constitute persons joint inventors it is not necessary that exactly the same idea should have occurred to each at the same time, and that they should work out together the embodiment of that idea in a perfected machine.

48 C.J. 120, Sec. 134.

McKinnon Chain Co. v. American Chain Co.,
(C.C.A. 3) 268 Fed. 353.

Ross & Co. v. Wigder, (C.C.A. 3) 290 Fed. 788.

Shreckhise v. Ritchie, et al., (D.C.W.D. Vir.) 67
F.S. 926.

Quincy Mining Co. v. Krause, (C.C.A. 6) 151
Fed. 1012.

*Thropp Sons Co. v. DeLaski & Thropp Circular
Woven Tire Co.*, (C.C.A. 3) 226 Fed. 941.

*Welsbach Light Co. v. Cosmopolitan Incandes-
cent Light Co.*, (C.C.A. 7) 104 Fed. 83.

Arnold v. Bishop, 1 F.C. 1165.

Bannerman v. Sanford, 99 F. 294.

American Patent Diamond Dop Co. v. Wood, 189
F. 391.

In the case of a joint invention, the patent should be obtained by the joint inventors, and a patent granted to one of joint inventors as the sole inventor, is void.

City of Milwaukee v. Activated Sludge, 69 F. (2d) 577, 587, C.C.A. 7 (1934), cert. den. 293 U.S. 576, 79 L. Ed. 673.

Tin Decorating Co. v. Metal Package Corp., 37 F. (2d) 5, 7, C.C.A. 2 (1930), cert. den. 281 U.S. 759, 74 L. Ed. 1168.

Larson v. Crowther, 26 F. (2d) 780, 789, C.C.A. 8 (1928), cert. den. 278 U.S. 648, 73 L. Ed. 560.

George v. Perkins, 1 F. (2d) 978, 979, C.C.A. 8 (1924).

Joseph Ross & Co. v. Wigder, 290 Fed. 788, 789, C.C.A. 3 (1923).

McKinnon Chain Co. v. American Chain Co., 268 Fed. 353, 360, C.C.A. 3 (1920).

Smart v. Wright, 227 Fed. 84, 87, C.C.A. 8 (1915).

Newgold v. American Electrical, etc., Co., 108 Fed. 957, 959 (1901), aff'd 113 Fed. 877, C.C.A. 2 (1902).

ARGUMENT

Plaintiff's witness Knox testified that in January, 1925, Harry Y. Stebbins came to the Utility Trailer Manufacturing Company, of which Knox was then chief engineer, with a six wheel attachment for motor vehicles in all respects similar to the structure illustrated in Figure 1 of the Knox patent in suit, except that in place of the universal joint on the end of the rocker arm shown in Figure 1 there was a pin and bushing hinge connection.

The following testimony was elicited at the time of taking of proof on behalf of the party Knox in the matter of *Garner L. Knox v. Albert H. Fager*, Interference No. 55,383, upon direct examination of Garner L. Knox (Exhibit No. 5):

"Q. 11 Tell, as fully as possible, the circumstances leading up to your conception and development of this invention.

A. Our company was manufacturing a six wheel attachment for Mr. H. Y. Stebbins.

Q. 12 What company do you refer to?

A. The Utility Trailer Manufacturing Company.

A. (Q. 13) We commenced the manufacture early in February, 1925.

A. (Q. 14) This Stebbins attachment did not provide for universal action between the rocker arm and the six wheel axle. * * * We continued manufacturing the Stebbins attachment for him without any universal and without this hinge point immediately above the axle, but did make a number of sketches showing various universal constructions.

Q. 24 Did you discuss the matter of the need of this universal attachment with Harry Y. Stebbins at this time?

A. Yes. I discussed with him the need of more flexibility in his attachment.

Q. 25 When did this discussion take place?

A. During February and March, 1925.

Q. 31 Can you describe the construction of the universal shown in any one of these sketches?

A. We have one tracing that is based on one of these sketches, which was never manufactured. It showed a rocker arm, in one end of which was journaled a horizontal shaft, this shaft having a hole at right angles to its length in the end of it.

Q. 36 When was it that you disclosed your idea of the use of a universal to Mr. H. C. Bennett, Mr. Clune and Mr. Stebbins?

A. On or before March 1, 1925.

Q. 38 Do you recall any particular discussion had with any one of these parties concerning this matter?

A. Yes; they all agreed that some universal action would be an improvement, but did not want to hold up manufacture of the attachments then in production.

Q. 48 Was Mr. Clune employed by the Utility Trailer Manufacturing Company?

A. No; he was a salesman for H. Y. Stebbins.

Q. 131 Are you now able to produce the drawing to which you referred earlier in your testimony as being an earlier drawing than Knox exhibits B, C and D, and which you said you would produce in response to Q. 35?

A. (to Q. 132) I submit drawing dated May 19, 1925, as being a tracing made from one of the early sketches previously referred to.

Q. 133 Who made this tracing?

A. The draftsman employed by Stebbins.

Q. 134 From what was the tracing made?

A. From one of these early sketches.

Q. 135 Who made the early sketches?

A. This particular sketch was made by Mr. Clune.

Q. 139 Did you give to Mr. Clune instructions and the idea of the construction as shown in this tracing?

A. No; I did not. This was his idea of a universal that could be incorporated in the six wheel attachments he then had in production."

In answer to defendant's suggestion that the structure claimed in the Knox patent is rightly the joint invention of Stebbins and Knox, plaintiff argued that Stebbins did not desire the substitution proposed by Knox; that Stebbins considered the substitution harmful and that the substitution would unduly complicate the structure. Such argument is, of course, untenable, for

it is universally recognized that in inventions involving combinations of elements the conceptions of use of the various elements need not and surely most frequently do not spring from the thoughts of one person. Nor, in the case of joint invention, is it necessary or even conceivable that such conceptions should come simultaneously in the minds of the parties. In *Quincy Mining Co. v. Krause*, 151 F. 1012, the Circuit Court of Appeals, Sixth Circuit, remarked:

"It is next said that the evidence tends to show that this idea of placing the outlet inside of the mortar was the thought of but one of the patentees, and therefore could not be the subject of a joint patent. If a claim covered but a single idea, it would be difficult to conceive how it could be patented by two, but, when a claim covers a series of steps or a number of elements in a combination, the invention may well be joint, though some of the steps or some of the elements may have come as a thought of but one."

In *Thropp & Sons Co. v. DeLaski & Thropp Circular Woven Tire Co.*, 226 F. 941, it was established that Thropp designed a major part of the device and that DeLaski designed a small but important part thereof. In holding the invention to be joint, the Circuit Court of Appeals, Third Circuit, stated:

"The claims of the patent which are in litigation are not for the elements of the machine but are all directed to the machine as a whole.

"In a machine containing as many elements as this one, it is not to be thought nor by the law required, that the inventive conceptions of two inventions shall develop simultaneously. One may conceive a general or imperfect outline of an entirely

novel thing, which, without the conception of another developing it and giving it body, might never amount to invention; but if the conceptions of one supplement and complement the conceptions of the other, the result might be invention and therefore joint invention.

“We are entirely satisfied that while Thropp first conceived the idea of wrapping a tire under pressure, his idea was in part developed by DeLaski, and that DeLaski’s ideas and contributions were so essential and were so related to the conception of Thropp that, without them, Thropp alone would not have produced the invention for which the patent was issued.”

An analogous situation is presented in the instant case by putting Stebbins in the shoes of Thropp and Knox in the shoes of DeLaski. Stebbins, like Thropp, conceived the general plan of the invention but Knox’s ideas and contributions were so related to the conception of Stebbins that, without them, Stebbins alone would not have produced the invention for which the patent was issued.

Plaintiff argues that Stebbins objected to the substitution of the universal joint for his simple link, and therefore cannot be considered as joint inventor with Knox. It is not understood that merely objecting to the substitution of one element for another for any reason was sufficient ground for Knox to appropriate to himself the entire combination, most of which was the sole conception of Stebbins. The Courts clearly observe that the various elements going to make up the combination may well be the result of independent thoughts of more than one person, and they do not require that

all parties must concur therein. It is readily conceivable that the basic conceptions of one party might be further developed by another without the direct knowledge of the former, and yet it could not justly be said that they did not collaborate in the development thereof. If such were the law, a person could secretly develop the basic invention of another and thereby confiscate the entire product.

Stebbins' objection to the substitution made by Knox merely indicates a difference of opinion as to the merits of the substitution. According to Knox, Stebbins erroneously believed the substitution would produce unsatisfactory operation. But it is unconscionable that a person should be penalized to the extent of losing his basic invention for such an error in judgment. Had Stebbins not been one skilled in the art, he might not have objected to the substitution. But the Courts hold that the conceptions of unskilled persons may be developed by a skilled party and a patent issued to them jointly. Thus, it is irrelevant whether Stebbins was skilled but held an erroneous opinion or was unskilled and had no opinion. Knox improved Stebbins' basic conception.

In *Ross & Co. v. Wigder*, 290 F. 788, Moffat conceived the idea of plating finger nail files with tin to improve the quality. Knowing nothing about electroplating, he commissioned King, an expert on plating, to do the work. Ordinary tin plating was unsuccessful, but plastic tin plating proved satisfactory. Moffat had no knowledge whatever of plastic tin plating, but the Circuit Court of Appeals, Third Circuit, held that Moffat and King were joint inventors of the novel file.

Thus, it is immaterial whether one of joint inventors is skilled or unskilled, and it is unnecessary to account for Stebbins' erroneous conclusion as to the merits of the substitution of the universal joint. Knox considered the substitution to be appropriate and his contention proved accurate. However, he would not have had the opportunity of perfecting Stebbins' device had not Stebbins consulted him in the first place.

In *Arnold v. Bishop*, 1 F.C. 1165, Bishop and McLean conceived of the idea of crossing wool diagonally. Their employer authorized Bishop to have Arnold make the machine. Arnold devised a machine having the vibratory and rotary motion necessary to produce the diagonal crossing of the wool, and then declared he was entitled to a patent as sole inventor of the device. Chief Justice Crane of the Circuit Court for the District of Columbia declared:

"The man who reduces to practice the theory of another who assists in the reduction of it to practice cannot be considered as the sole inventor of the machine. Arnold would not have made the machine unless informed by Bishop of the discovery he had made of the effect of the diagonal crossing of the wool. The invention consists both of the discovery of the principle and the reduction of it to practice. Neither Bishop nor Arnold, therefore, could be considered as sole inventor."

In *Bannerman v. Sanford*, 99 F. 294, the Circuit Court of Appeals, Second Circuit, observed:

"Roper, having with Spencer, invented and constructed a machine which contains a certain useful combination, thereafter takes out a patent in his own name covering this very combination. If the

prior machine produced by both men, and known to both, does not disentitle Roper to cover such combination in his patent, it would not disentitle Spencer to cover the same combination in a patent to himself; and we would have two joint inventors, each rightfully holding a separate patent for the same invention, which is absurd."

Similarly, Stebbins and Knox both contributed to the development of the structure ultimately patented by Knox. Thus, if this finished device, produced by the efforts of both Stebbins and Knox and known to both, does not disentitle Knox to patent it, it would not disentitle Stebbins to patent it. As the Court reflected, we would then have two joint inventors, each rightfully holding a separate patent for the same invention, which is absurd.

In *American Patent Diamond Dop Co. v. Wood*, 189 F. 391, the Circuit Court, E.D. New York, held valid a patent issued jointly to father and son as inventors of a diamond dop, although the son testified that the bifurcated finger was the sole conception of the father. The Court stated:

"This testimony (while it may show that greater credit belonged to the father as to certain parts of the structure, or that the father might have worked out the bifurcated finger himself) does not go so far as to indicate that the patent should be held invalid because one feature of it, even though it be an important feature, was thought by one of the two who worked out the entire invention, for otherwise it would be impossible to hold that two individuals could jointly participate in inventing a structure, as it must necessarily happen that some of the concepts representing various steps in the

invention should occur to first one and then the other, and yet the invention, as a whole, be the joint product of the two."

In *McKinnon Chain Co. v. American Chain Co.*, 268 F. 353, Hoff conceived of the idea of welding chain electrically. He talked with Coulter about the plan and requested Coulter to manufacture it. Hoff had the idea of forming the chain links about two mandrels by the simultaneous and successive movement of arms about the mandrels. The device made by Coulter embodied the arm movement of Hoff but contained only one mandrel. The patent which issued to Coulter was declared invalid by the Circuit Court of Appeals, Third Circuit, as follows:

"Not having lost sight of the fact that the patent is for a combination, we can conceive that if Hoff's simultaneous and successive arm movements had been a part of the prior art, Coulter might have taken them, and, adapting them to a single mandrel, might have made in that combination a new invention. There invention would have resided solely in the combination, in no degree in its elements, and Hoff might not be heard to complain. But Hoff's conception, which he gave Coulter to develop mechanically, was not then a part of the art, either prior or present. The machine then contained in combination Hoff's conception and what we have assumed was Coulter's conception, so combined and interrelated that the presence of each was indispensable to the functioning of the other, for without either the machine would not work.

"As both Hoff and Coulter had at one time—the crucial time—worked together for a common end, which was finally accomplished by the contributions and united efforts of both, we are of opinion, after applying familiar laws to the facts, that the

invention was the invention of both, and was, therefore, joint invention. (References cited.)

"On this finding it follows that the award of the patent to Coulter as the sole inventor was unlawful, and that, in consequence, the patent, as to the claims in suit, is invalid."

Nor can plaintiff justify the procurement of Letters Patent to Knox by showing that Stebbins acquiesced in the knowledge of Knox's efforts to obtain a patent in his own name. This was the situation in the case of *Shreckhise v. Ritchie, et al.*, 67 F.S. 926, and the District Court, W.D. Virginia, held the patent void, stating that even if the other joint inventors knew of Shreckhise's efforts to obtain a patent in his own name and acquiesced therein,

"* * * it could not serve to make valid in Shreckhise's hands a patent which was void from the beginning."

Another similarity in the instant case and that of *Shreckhise v. Ritchie, et al.*, is in the fact that when the patentees applied for Letters Patent, the Patent Office knew nothing of the joint nature of the venture, but had to rely upon the oaths of the individual patentees. In the cited case, the Court stated:

"It is true that the issuance of a patent carries a prima facie presumption of its validity. But the force of this presumption is weakened when the ground upon which validity is assailed was not in issue before the patent office and never known or considered there. In the instant case the patent issued to Shreckhise on his representation that he was the sole inventor. Had the true facts been disclosed at the patent office I have no doubt the application would have been rejected."

The above discussed cases present situations substantially the same as those presented in Mr. Knox's testimony in the instant case, and the Courts' decisions in these cases have been unanimous in finding joint invention where a device had been perfected through the efforts of two or more parties. In the present case, Stebbins provided an entire structure which, though somewhat deficient in practical operation, provided Knox with the basis upon which he was able to devise means for obtaining improved operation thereof. Accordingly, if the rulings and reasonings of the Courts as discussed hereinabove are to be recognized, it is plain that if, in fact, the substitution of a universal joint for the simple link connection of the Stebbins structure involves invention, the ultimate product of the combination as claimed is truly the joint invention of Stebbins and Knox. Appellant herein submits that since the patent in suit was issued to Knox as sole inventor of the device jointly developed by both Stebbins and Knox, the patent is invalid.

POINTS AND AUTHORITIES ON ASSIGNMENT OF ERRORS GROUP V

Amendment to conform to proof may be made at any time, even after decision.

Rule 15 (b) Federal Rules of Civil Procedure.

American Land Co. v. City of Keene, 41 F. (2d) 484 (C.C.A. 1).

Gulf Smokeless Coal Co. v. Sutton, Steele & Steele, 35 F. (2d) 433 (C.C.A. 4).

ARGUMENT

Garner L. Knox testified repeatedly that the structure invented by Harry Y. Stebbins was as illustrated in Figure 1 of the Knox patent in suit, except that the structure shown in the Knox patent includes a modified form of universal joint incorporated in the structure at the place where Stebbins had provided a simple hinge pin and bushing. Mr. Knox testified further that he discussed with Mr. Stebbins the matter of more flexibility in the Stebbins attachment, and that Mr. Stebbins, among others, agreed that some universal action would be an improvement (Ex. 5, p. 6). Further testimony of Mr. Knox in this connection is to be found on pages 71-72 of the record of Interference No. 55,383 (Exhibit 5) where Mr. Knox testified:

“Mr. Stebbins had brought us his idea of a six wheel attachment and made arrangements with us to manufacture them for him. As he had no drawings of this rocker arm type, he showed me by sketches what and how he wanted it built so that I could give the necessary orders to our shop to have these parts made. As I knew what equipment we had, I worked with him to the extent of making suggestions regarding practically all of the details of these parts so that they could be manufactured by us without undue cost. The discussions with Mr. Bennett and with Mr. Klune developed naturally through our mutual interest in getting a satisfactory device and likewise an inexpensive one on the market.” (p. 71)

At the trial of the instant cause, Mr. Knox testified:

“Q. Are each of the elements named in the claims of the Knox patent, for example hanger brackets secured to the frame, rocker arm pivotally sup-

ported by the brackets, means for securing one end of the arms to one end of the spring supporting the rear end of the frame, an axle, universal means for securing the axle at the opposite sides of the frame to the rocker arms and wheels journaled on the axle,—are each of these elements necessary and material to the successful operation of this device?

A. Yes.

Q. Then, Mr. Stebbins having brought to you what he conceived to be his invention and you adding thereto a single element which you believed to be your invention, combining the entire structure in the claims of your patent, why did you execute an oath saying that you were the sole inventor?

A. I am not aware that in an invention you have to invent everything that is involved in the claims.
* * *

Q. Nevertheless, you employed that particular arrangement of elements in exactly that relationship in your structure, and wrote claims covering that particular arrangement of elements in addition to your universal joint, isn't that true?

A. Yes, the claims claimed in mine involve the elements of the Stebbins as well as the Van Leuven patent, plus the universal." (Tr. 117-118)

Thereupon, defendant's counsel made application to the District Court to amend defendant's pleadings to include as a separate, alternative defense that the Knox patent in suit is invalid for the reason that the application for patent was executed by Garner L. Knox as the sole inventor, whereas it is clearly evident that the invention was the joint invention of Garner L. Knox and Harry Y. Stebbins.

The court deferred ruling on the motion until the end of the case. Thereafter, on June 14, 1948, the Dis-

strict Judge made findings of fact and conclusions of law reading in part as follows:

“FINDINGS OF FACT AND CONCLUSIONS
OF LAW

22.

“That claims 1, 2, 11, 15 and 17 of the Knox patent in suit, No. 1,926,727, define an invention made by Garner L. Knox which overcame the problem existing in this art.

“CONCLUSIONS OF LAW

2.

“That Letters Patent No. 1,926,727 in suit is good and valid in law, particularly as to claims 1, 2, 11, 15 and 17 thereof, and that said patent and claims cover a new and meritorious invention.”
(Tr. 24)

Defendant's motion was, in effect, to amend his Answer to conform to the evidence. Cross examination of plaintiff's witness Knox had developed the fact that the structure disclosed in the Knox patent in suit, minus the universal joint, was considered to be an invention by Stebbins, and for which Stebbins had filed application for United States Letters Patent. Mr. Knox had contributed to that structure a modified form of universal joint which he believed to be necessary, taking the entire Stebbins structure and improving a single element thereof by making of it a universal joint to prevent the wear which had been taking place between a hinge pin and its bushing.

The issue as to whether Garner L. Knox was a sole inventor or a joint inventor with Harry Y. Stebbins was

tried with the express or implied consent of the plaintiff, since the evidence was not objected to at the trial on the ground that it was not within the issues made by the pleadings. Rule 15 (b) provides that:

“When issues not raised by the pleadings are tried by express or implied consent of the parties, they shall be treated in all respects as if they had been raised in the pleadings.”

The Court of Appeals is respectfully urged to consider the amendment as having been made. Rule 15 (b) further provides as follows:

“Such amendment of the pleadings as may be necessary to cause them to conform to the evidence and to raise these issues may be made upon motion of any party at any time, even after judgment; but failure to so amend does not affect the result of the trial of these issues.”

In *Gulf Smokeless Coal Co., et al. v. Sutton, Steele & Steele, et al.*, (C.C.A. 4) 35 F. (2d) 433, 3 U.S.P.Q. 82, it was held that the plaintiff obtained leave to amend in the trial court to state grounds for relief against a party added by court order, but he did not amend. It was held that he could amend in the appellate court to conform to proof, or the appellate court could consider the amendment as made. Circuit Judge Parker said:

“The pleadings seem not to have been actually amended in accordance with the order, but no inconvenience was caused to the Company as the result of this neglect nor has it been taken by surprise in any way.”

In the instant case evidence that Garner L. Knox was a joint inventor with Harry Y. Stebbins was de-

veloped on cross examination of plaintiff's witness on matters first brought out by plaintiff's counsel on direct examination. The plaintiff could not have been taken by surprise, since it supplied the evidence upon which defendant bases his motion to amend his pleadings. Appellant avers that the District Court erred in not ruling on defendant's motion to amend; but since "failure so to amend does not affect the result of the trial of these issues", it is requested that the Court of Appeals consider the amendment as having been made.

POINTS AND AUTHORITIES ON ASSIGNMENT OF ERRORS GROUP VI

The selection and putting together of the most desirable parts of different machines in the same art, where each separate part is selected solely to perform the obvious purpose for which it was used in the prior art, is not invention, but rather the evolution of the mechanical ability of one skilled in that particular art.

Adams v. The Galion Iron Works & Mfg. Co.,
(C.C.A. 6) 42 F. (2d) 395; 6 U.S.P.Q. 69.

*Atlas Trailers & Water Mufflers, Inc. v. Gray's
Iron Works, Inc., et al.*, 43 F. (2d) 191; 6
U.S.P.Q. 276. Aff'd 54 F. (2d) 1075; 12 U.S.
P.Q. 354.

The Fisher Governor Co., Inc. v. C. F. Camp Co.,
(C.C.A. 10) 40 F. (2d) 341; 5 U.S.P.Q. 393.

*National Hollow Brake Beam Co. v. Interchange-
able Brake Beam Co.*, (C.C.A. 8) 106 F. 693.

The T. F. Rowley Co. v. Albert T. Rowley, 39 F.
(2d) 865; 5 U.S.P.Q. 212.

R. G. LeTourneau, Inc. v. Gar Wood Industries, Inc., (C.C.A. 9) 151 F. (2d) 432; 67 U.S.P.Q. 165.

Brill v. Washington Railway Co., 215 U.S. 527; 54 L. Ed. 311; 30 S. Ct. 177.

Hazeltine Research, Inc. v. General Motors Corp., (D.C.E. Mich.) 72 F.S. 138, 74 U.S.P.Q. 85.

ARGUMENT

Garner L. Knox, on the occasion when the Stebbins structure was originally presented to him, suggested incorporating in the Stebbins structure a universal joint where the end of the rocker arm connected with the yoke 15, although, according to the testimony of Mr. Knox, Mr. Stebbins objected to such modification.

"A. As soon as the first one was built, which, incidentally, was not built to our drawings, Stebbins came out and personally directed our mechanic how he wanted it. As soon as the structure was put together, we saw the stiffness in there and tried to get him to put a universal in, but he was opposed to complicating it; thought it was not necessary.

THE COURT: You thought it was necessary at all times?

A. Yes." (Tr. 77)

The language of Judge Walter H. Sanborn in *National Hollow Brake Beam Co. v. Interchangeable Brake Beam Co.*, supra, seems to be especially appropriate in the instant case. Judge Sanborn said:

"There are some mechanical devices so obvious and appropriate for the performance of their accustomed functions that the common knowledge and experience of those unskilled in mechanics, to say nothing

of those learned in the art, at once suggests their use when the results which they customarily attain are desired.”

In the same case, the same able jurist, speaking of the use of a wedge in a new combination, held:

“Neither the intuition of the inventor, nor the skill of the mechanic is required to suggest the fitness of a wedge to take up slack, to prevent lost motion in, or to tighten the loose members of, a mechanical device. Its fitness for these purposes is common knowledge, and has been taught by the common experience of mankind.”

And in speaking of the use of retaining lugs in a patentable combination, Judge Sanborn said:

“There can be neither discovery nor invention in applying a remedy so plain to, or in combining a contrivance so obvious with, an old mechanical device which needs it.”

There is no more invention in the combination of a universal joint in any of its usual forms, discharging its customary function of permitting a shaft to have oscillatory movement, with Stebbins six wheel attachment than there is in the discovery of the universal joint itself and its common use for a multitude of purposes. If this were not true, every combination of an old device with a universal joint, performing its well known and expected function, would constitute an invention.

The principle of law thus stated was applied by Circuit Judge Hicks in *The T. F. Rowley Co. v. Albert T. Rowley*, 39 F. (2d) 865; 5 U.S.P.Q. 212, where the court said:

"The ball bearings introduced by J. F. Rowley and located in races upon the outer surface of the shaft (patent No. 1,090,881) reduced the area of the surfaces brought into contact with each other and converted sliding friction into rolling friction and thus in a large measure eliminated the squeak. But ball bearings are old. They are in general use, and it is commonly understood that they reduce friction and the attendant noises and it is obvious that their use here arose out of nothing more than the thought of a mechanic. It was not invention. It was simply the adaptation of an old device to the same use in a different structure. * * * They accomplish no other purpose in Rowley's ankle joint than they would accomplish in any other relationship."

In *The Fisher Governor Co., Inc. v. C. F. Camp Co.*, (C.C.A. 10), *supra*, plaintiff substituted ball bearings for plain bearings on the float in a gas and oil separator tank to reduce friction and overcome sticking of the shaft. Plaintiff conceded that the float without the ball bearings was in use long before the patent was applied for; and, further, that the use of ball bearings to resist radial and end thrust was old in the arts. It contended that there was patentable invention in discovering the difficulty and remedying it; and patentable invention in adapting ball bearings to a float mechanism. Circuit Judge McDermott delivered the opinion of the court:

"Ball bearings are old; their use is public property; their peculiar function is to reduce friction. In our opinion, one cannot avail himself of this ancient principle in a new device, and appropriate the idea to his exclusive use. At best, it involves no more than mechanical ingenuity to substitute ball bearings on a shaft which sticks in a plain bearing."

In *R. G. LeTourneau, Inc. v. Gar Wood Industries, Inc.*, (C.C.A. 9) 151 F. (2d) 432, 67 U.S.P.Q. 165, the Circuit Court of Appeals for the Ninth Circuit affirmed the principle of law that using an old device for an old result is not invention. Circuit Judge Stevens said:

“Was LeTourneau’s adaptation of a cable system to accomplish the results achieved in his scraper a matter of invention? LeTourneau connected a cable to a load moving device. With one cable he moved two different loads, and by allowing for their varying weights, he moved them in sequential order. Such results had been accomplished before by means of cable systems. Therefore, LeTourneau merely utilized an old device for an old result, namely, the moving of loads in sequential order. Such a combination does not involve the exercise of inventive genius.

“As the Supreme Court explained in *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 90: ‘We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statutes (35 USC Sec. 31; R.S. Sec. 4886) the device must not only be “new and useful”, it must also be an “invention” or “discovery” * * *. Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art.’ ”

The decision of the Supreme Court of the United States in *Brill v. Washington Railway Co.*, 215 U.S. 527; 54 L. Ed. 311; 30 S. Ct. 177, appears to be particularly appropos in the instant case. Mr. Justice Holmes rendered the opinion of the court:

“We are not dealing with a new type of trucks, but with certain features only. * * * In that claim the only possible element of novelty is the mode in which the semi-elliptic springs are suspended from the side frames. In practice the links are elastic and the pins on which the whole combination hangs have a universal ball and socket movement, although the claim only says ‘movably and resiliently suspended * * * substantially as described.’ * * * We agree, however, with the Circuit Court of Appeals, that the substitution of a ball and socket movement for the movement in one direction of the Thyng link, coupled, as it was with a slight longitudinal play, required a minimum of invention. A link having universal movement was patented by Beach in 1876. The plaintiff’s witness Akarman says that there always has been provision made for lateral and longitudinal motion in every well constructed truck.”

Every element disclosed in the Knox patent 1,926,727 and recited in the claims in suit is provided by the Stebbins six wheel attachment and the prior art. A good mechanic having the Stebbins structure and being confronted with the problem of providing more flexibility between the rocker arm and the axle of the attachment, and having the benefit of such prior art patents as Smith 1,111,924, Collard 1,131,118, Laisne 1,316,369, and McCracken 1,527,987, could have done the thing which Garner L. Knox did without any invention whatever, just as Knox did it. We quote from the decision in *Hazeltine Research, Inc. v. General Motors Corp.*, (D.C.E. Mich.) 72 F.S. 138, 74 U.S.P.Q. 85, wherein District Judge Lederle said:

“Where, as here, it appears that a patentee has merely accomplished an old result by a combination of

means which, singly or in similar combination, were disclosed by the prior art, and the patentee has made no advance over the prior art beyond that which would be accomplished by a mechanic skilled in the art, there is no patentable invention, 35 U.S. C.A. 31; *Detrola Radio etc. Corp. v. Hazeltine Corp.*, 313 U.S. 259; *Cleveland Punch & Shear Works v. Bliss Co.*, 145 F. (2d) 991."

CONCLUSION

We submit that plaintiff's patent is invalid for lack of novelty or invention, and that the trial court was in error in sustaining the patent. The scope of the claims in suit is delimited by the form and structure disclosed in the specification and drawings, and since defendant does not use that form or structure he does not infringe. The District Court erred in giving plaintiff any relief.

We submit that Garner L. Knox, the patentee of Letters Patent No. 1,926,727, invented nothing. Application for United States Letters Patent for the six wheel attachment had been filed by Harry Y. Stebbins. Harry Y. Stebbins and his assignee, Utility Trailer Manufacturing Company, conceded priority of invention to David L. Van Leuven. The Harry Y. Stebbins structure is covered by the claims of Letters Patent No. 1,655,481, to Van Leuven. Each of the structures of Stebbins and Van Leuven was prior in time to the date of alleged conception of invention by Garner L. Knox. Knox's only contribution to the device disclosed, described and claimed in his patent was the substitution of a modified form of universal joint for the simple hinge pin and

bushing employed by Stebbins for securing the rocker arm to the axle of the attachment.

All of the elements disclosed in the Knox patent in suit were already in combination and already well known, singly or in groups, as common expedients in similar situations, and the substitution of any one of the several well known forms of universal joints for the simple hinge pin and bushing in the Stebbins structure can hardly be said to justify the patent. The combination of the Stebbins structure and the particular form of universal joint selected by Knox did not produce some new result going beyond that which may have been achieved by mere mechanical skill in operating the elements disclosed by the prior art.

We submit that the improvement of any part or element of an old combination gives no right to claim that improvement in combination with other old parts or elements which perform no new function in the combination. It is clear that the Knox "invention" was not the *combination* of elements defined by his claims, but rather the improvement of a single element of a prior art structure by reason of his substitution therefor of a universal joint. It is submitted that Garner L. Knox was not the inventor of the combination claimed, and that the patent is void as claiming more than the patentee invented.

We submit that if, by any stretch of imagination, plaintiff is entitled to any range of equivalents sufficient to bring defendant's structure within the scope of the claims in suit, then by the same token the patent

to Pratt 878,156, the British patent to Spencer 8262 of 1906, or the patent to Mohl 1,534,458, completely anticipate the structure defined by claims which read on defendant's FEATHER RIDE suspension.

We submit that the testimony of Garner L. Knox establishes beyond a reasonable doubt that he and Harry Y. Stebbins were joint inventors of the subject matter disclosed, described and claimed in the Knox patent in suit; and the fact that Harry Y. Stebbins had agreed that some universal action would be an improvement, but did not want to hold up manufacture of attachments then in production, did not give Knox the right to apply for a patent as the sole inventor. Since the patent in suit was issued to Knox as sole inventor of a device jointly developed by Harry Y. Stebbins and Garner L. Knox, the patent is invalid.

Finally, we submit that in view of the state of the art, and analogous arts, and in view of what was common knowledge on the part of those skilled in the art, and analogous arts, at the time of and long prior to the alleged invention or discovery made by the said Garner L. Knox, the subject matter and disclosure of the patent in suit did not involve patentable discovery or invention, and involved nothing more than the exercise of mere mechanical skill.

We ask the Court's indulgence for the length of this brief. Invention and patentability are largely questions of fact. To make them clear, involving, as it does, problems of mechanics and physics, is not easy, as it is difficult to make clear by written word that which ob-

jectively is obvious, and this has compelled us to extend the length of this brief so that a manifest injustice may be corrected.

The decree should be reversed and defendant absolved from liability.

Respectfully submitted,

HAROLD L. COOK,
717 Corbett Building,
Portland 4, Oregon,
Attorney for Appellant, R. W. Pointer.

COOK AND SCHERMERHORN,
Attorneys for Appellant, R. W. Pointer,
717 Corbett Building,
Portland 4, Oregon.